

REMARKS

Claims 1-30 are pending in the present application. Applicant respectfully requests that the above-identified application be reconsidered in view of the following remarks.

Examiner Interview

Applicant's attorney wishes to thank the Examiner for his time to discuss the Inokuchi and Root references and the pending claims on May 14, 2003. No agreement was reached as to patentability, though it was agreed that each of the pending claims recites a magnetic ink substance. As stated in the previous Office Action responses and below, none of the cited references discuss or teach a magnetic ink substance and, therefore, do not render obvious the claimed invention of magnetizing ink or varying magnetic flux to a magnetic ink.

During the interview, the Examiner identified U.S. Patent No. 5,215,397 to Taguchi et al. as disclosing magnetic ink. Since this reference does not appear in Applicant's IDS or in any of the Office Actions in this case, Applicant has cited it in a supplemental IDS submitted with this Request for Reconsideration.

The 35 U.S.C. § 103(a) Rejections

Claims 1-22 and 24-30 were rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 3,819,857 to Inokuchi ("Inokuchi") in view of U.S. Patent No. 5,600,781 to Root et al. ("Root"). Claim 23 was rejected under 35 U.S.C. § 103(a) as being unpatentable over Inokuchi in view of Root in further view of U.S. Patent No. 5,546,538 to Cobbley et al. ("Cobbley"). Claim 1 was further rejected under 35 U.S.C. § 102(b) as being anticipated by Root.

Response to Applicant's Arguments

The Final Office Action states as follows:

"Applicant argues in essence that Inokuchi does not teach 'magnetic ink'. With respect to applicant's argument the Examiner disagrees and indicates Inokuchi teaches the following features: (Fig. 9, item 94, column 5, lines 53-59, which clearly mention pen 91 **made of magnetic material and ink 94** stored in the pen holder 93 is supplied through this opening to write a pattern on table sheet.

Root et al discloses information is stored in a standardized magnetic ink format known as the "JOT" form (column 5, lines 57-66)." (emphasis in original)

Inokuchi

The title of the Inokuchi patent is "Electromagnetic Induction Type Pattern Input Apparatus." Induction, as readily known in the art, refers to the interaction of electrical coils. To that end, coils in the tablet sheet 8 interact with a coil 10 wrapped around a magnetic rod 9 (See Fig. 3). Magnetic ink is neither taught nor suggested in Inokuchi. The reference does, however, mention "ink" as item 94 at Col. 5, lines 53-59. The entire paragraph reads as follows:

"Where it is desired to simultaneously write the input pattern on the paper, an electromagnetic pen 90 as shown in Fig. 9 is used. More particularly, in this pen 90, a fine opening is perforated through a pen 91 made of magnetic material and ink 94 stored in the pen holder 93 is supplied through this opening to write a pattern on the tablet sheet."

Grammatically, the second sentence of this paragraph would be nonsensical if the term "magnetic" is an adjective for "ink 94." Assuming that "magnetic" describes "ink

94" as suggested by the Examiner, then the phrase "through a pen 91 made of magnetic material and ink 94" is a prepositional phrase serving as an adverb for the verb "perforated." Setting aside the prepositional phrase, the sentence would read as follows:

More particularly, in this pen 90, a fine opening is perforated stored in the pen holder 93 is supplied through this opening to write a pattern on the tablet sheet.

This sentence, of course, is grammatically incorrect, and including "and ink 94" as part of the prepositional phrase renders the sentence nonsensical. The intended prepositional phrase is "through a pen 91 made of magnetic material" and serves as an adverb for the verb "perforated." Setting aside this prepositional phrase, the sentence reads as follows:

More particularly, in this pen 90, a fine opening is perforated and ink 94 stored in the pen holder 93 is supplied through this opening to write a pattern on the tablet sheet.

This sentence is grammatically correct. Thus, the term "magnetic material" in this paragraph is describing the composition of the pen (just like magnetic rod 9 in Fig. 3) and not describing ink 94. As further support, claims 4 and 11 of Inokuchi appear to provide the only other mention of the term "ink" in this patent. The text of those claims supports the construction of the paragraph at Col. 5, lines 53-59 given above. Claim 4 recites an electromagnetic pen comprising "a pen holder having therein an ink reservoir and a magnetic pen having a passage communicating with said ink reservoir." Again, the term "magnetic" is used to describe the pen and not the ink in the ink reservoir.

Root

Root refers to handwriting recognition. Though the term "magnetic ink" is used, no ink substance is described, especially an ink substance that can be magnetized (e.g., when subjected to a varying magnetic flux). The disclosure of Root is easily described with respect to Fig. 1 on the front page of the patent. A "personality profile" is stored on the card in PCMCIA slot 110, which stores parameters allowing the computer 100 to recognize the handwriting of the user using electromagnetic pen 120 on CRT screen 130. There is no ink coming out of pen 120, and it is inconceivable that one would want to deposit ink of any kind onto a Cathode Ray Tube (CRT) screen.

Column 5, lines 57-66 refers to the storing of handwriting information in "a standardized magnetic ink format [known] as the 'JOT' format. The JOT format contains rich attributes required to accurately represent digital ink." These two sentences describe the storing of handwriting information as "magnetic ink" and "digital ink." These terms are synonymous and refer to how data is commonly stored in computers, as binary "1"s and "0"s in a RAM memory, a magnetic hard disk, etc. In Root, the handwriting information is to be stored on the PCMCIA card in slot 110 so that it can be ported to different computers (See Col. 5, lines 28-42).

In its previous Amendment, Applicant has submitted excerpts from the referenced JOT specification. The Final Office Action, however, provides no further support from the Root reference or the JOT specification document for interpreting the term "magnetic ink" used therein as a physical substance.

The '397 Patent (Taguchi)

Though U.S. Patent No. 5,215,397 to Taguchi et al. ("Taguchi") has neither been cited nor used as prior art reference to reject the pending claims, Applicant wishes to address the Examiner's contentions concerning this reference. At Col. 3, lines 7-9, Taguchi states, "[t]he writing means may be means to draw lines using ink which

includes a magnetic substance and the hand-writing detection means may be a magnetic sensor." There is no other discussion of ink using a magnetic substance in the reference. Taguchi is referring to how the circuitry in the pen is able to record the movement of the pen. In several of the embodiments, this is achieved with optical sensors sensing where ink has been placed by the moving pen. The sentence above refers to detecting ink, which includes a magnetic substance, that has been placed on the paper with a magnetic sensor in the pen. Accordingly, there is no disclosure in Taguchi for storing or encoding an information signal in a magnetic ink having a magnetic substance or varying magnetic flux to a magnetic ink. One or more of these features are found in each of the pending claims.

In view of the above, reconsideration and withdrawal of the rejection of claims 1, 5, 6, 20, and 24 and claims 2-4, 7-19, 21-23, and 25-30 which ultimately depend from claims 1, 6, 20, and 24, respectively under 35 U.S.C. § 103(a) is respectfully requested.

CONCLUSION

For all the above reasons, the Applicant respectfully submits that this application is in condition for allowance. A Notice of Allowance is earnestly solicited.

The Examiner is invited to contact the undersigned at (202) 220-4255 to discuss any matter concerning this application. The Office is hereby authorized to charge any additional fees or credit any overpayments under 37 C.F.R. § 1.16 or § 1.17 to Deposit Account No. 11-0600.

Respectfully submitted,
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